

**REMARKS**

In response to the communication dated February 18, 2004, Applicants provisionally elect Group IV with traverse, and submit amendments to the claims.

In this action, the Examiner withdraws a September 16, 2003 restriction and now requires restriction under 35 U.S.C. § 121 between the following groups of claims:

Group I - Claims 1-20, drawn to polynucleotides and means of expression;

Group II - Claims 29-45, 54-55 and 57, drawn to polypeptides,

Group III - Claim 56, drawn to a method of screening; and

Group IV - Claims 58-61, drawn to methods of treatment.

The Examiner states that Group II is related to Group III and to Group IV as product and process of use, but that the Groups are properly restricted because the products can be used in a materially different process. The Examiner argues that the methods of Group III are unrelated to the methods of Group IV because they have different method steps, different goals, and different outcome measures. Additionally, the Examiner states that other Groups are unrelated because they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects.

**Provisional Election**

Applicants provisionally elect with traverse to prosecute Group IV, claims 58-61, drawn to methods of treatment. Additionally, Applicants submit amendments to the claims with this response to remove dependency from non-elected claims and to add new claims 61-67 which are drawn to methods of treatment. Like claims 58-61, provisionally elected herein, the new claims comprise administering a therapeutically

effective amount of a P-selectin ligand protein to a subject. As discussed below, Applicants believe that the new claims may be properly examined with Group IV.

Applicants believe that this restriction requirement is improper. While the Examiner has alleged that the claims are drawn to independent and distinct inventions, she has not shown that it would be a burden to examine the claims together. For a restriction requirement to be proper, the Examiner must show that both (1) the inventions as claimed are independent and distinct, and (2) there would be a serious burden on the Examiner if restriction were not required. M.P.E.P. § 803. The Examiner has focused on only the first part of this two-part test.

In order to properly restrict the groups, the Examiner needs to show that there would be a serious burden in examining the claims together. Here, the Examiner merely asserts that the searches required are different. The claims all relate to a novel P-selectin ligand protein and its uses, said protein comprising specific portions of SEQ ID NO:2. Applicants believe that no separate search would be required, particularly for Groups III and IV, and that the Examiner has not shown that a serious burden exists.

#### **Preliminary Amendment**

Applicants have amended claims 1, 14, 29, 39, 55, 56, and 58-61, and added new claims 62-69. Claim 1-20, 29-45 and 54-57 have not been marked withdrawn in the amended claims because the Examiner has not formally withdrawn the claims and we provisionally elect with traverse. The amendments introduce no new matter. Amendments of claims 58-61 are supported, for example, in claim 29 as filed, and at page 21, line 35 to page 22, line 15; and page 1, lines 22-24. Support for new claims 62-69 is found at page 1, lines 22-24; page 5, lines 25-32; page 10, lines 8-13; page 11,

lines 29-34; page 12, lines 35-37; page 13, line 16 to page 14, line 24; page 21, lines 34 to page 22, line 17; page 48, lines 11-19; page 49, lines 28-30; and Figure 12, for example.

The new claims are drawn to methods of treatment, and Applicants believe that all new claims fall within provisionally elected Group IV. Like the claims of Group IV, the new claims relate to methods of treatment, comprising administering a therapeutically effective amount of a P-selectin ligand protein to a subject. Similarly, the protein to be administered in new claims 62-69, comprises amino acid 42 to amino acid 60 of SEQ ID NO:2. Applicants, thus, request that the new claims be examined with the claims of Group IV if the current restriction is maintained.

In view of the foregoing amendments and remarks, Applicants respectfully request examination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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